



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,320	09/27/1999	GUIDO M. SCHUSTER	99.373	1480

20306 7590 10/30/2002

MCDONNELL BOEHNEN HULBERT & BERGHOFF
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

EXAMINER

HOOSAIN, ALLAN

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/406,320

Applicant(s)

SCHUSTER ET AL.

Examiner

Allan Hoosain

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-47 and 51-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 54-57 is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-47 and 51-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

FINAL DETAILED ACTION

Allowable Subject Matter

1. Claims 54-57 are allowed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-2, 9-10, 20, 22-23, 26-30, 36-38, 41-43, 45, 47 and 51-53 are rejected under 35 U.S.C. 102(e) as being anticipated by **Kelly** (US 5,999,965).

As to Claim 1, with respect to Figures 1-6, **Kelly** teaches a system for providing advertising on a data network telephony system comprising:

a data network to provide data connectivity for a plurality of data communications channels using data transport protocols (Figure 4, label 440);

a commercial message server, 500, being operable to send at least one commercial message (Figure 5, Col. 12, lines 14-25 and Col. 16, lines 25-30);

a first and second data network telephone connected to the data network, each data network telephone operable to communicate voice signals as data packets on a voice over data

Art Unit: 2645

channel, the voice over data channel being one of the plurality of data communications channels on the data network containing packetized voice signals, the data network telephones being operable to convert data packets communicated on the voice over data channel to voice (Figure 4, labels 420 and 430);

a network telephony connection server, 510, being operable to provide telephony service to data network telephones and communicate at least one commercial message request with the commercial message server (Figure 3A, Col. 12, lines 14-25 and Figure 5, Col. 16, lines 25-30); and

the first data network telephone being operable to receive the commercial messages while communicating voice signals as data packets, the first data network telephone further comprising a message display device to display the commercial messages (Col. 16, lines 32-39 and line 64 through Col. 17, line 4).

As to Claims 2, 9-10, **Kelly** teaches the system of Claim 1 wherein:

at least a first and second user communicate on the voice over data channel (Figure 5, labels 520, 530);

each user identified by a user identifier that includes a unique sequence of alphanumeric elements (Col. 8, lines 19-26 and Col. 16, lines 1-4).

As to Claims 20,22-23, with respect to Figures 1-6, **Kelly** teaches a method for advertising on a telephony system, the method comprising the steps of:

receiving a request to initiate a telephone call between a first data network telephone to a second data network telephone over a data network, the first and second data network telephones having a display screen, the request containing a caller user identifier to identify a first user of the first data network telephone, and a callee user identifier to identify a user of the second data network telephone (Col. 15, line 54 through Col. 16, line 15);

communicating a commercial message request to a commercial message server, 316,
(Figure 3A and Col. 12, lines 14-25);

retrieving at least one commercial message from a commercial message server (Col. 16, lines 25-29);

sending the at least one commercial message to the first data network telephone (Col. 16, lines 25-29); and

receiving the at least one commercial message at the first data network telephone while the first data network telephone is communicating voice signals as data packets (Col. 16, line 64 through Col. 17, line 4).

As to Claims 26,28-29,41,45, with respect to Figures 1-6, **Kelly** teaches a method of providing advertising services comprising the steps of:

storing at least one commercial message in a commercial message database (Col. 16, lines 25-29);

communicating with a telephony service provider to receive connection information, the connection information including at least a user identifier corresponding to a user of a data network telephone (Col. 15, line 44 through Col. 16, line15);

Art Unit: 2645

sending at least one commercial message request (Col. 12, lines 14-25 and Col. 16, lines 25-29)

sending at least one commercial message to the data network telephone while the data network telephone is communicating voice signals as data packets (Col. 16, lines 25-29 and line 64 through Col. 17, line 4); and

displaying the commercial message at the data network telephone (Col. 16, lines 35-39).

As to Claim 27, **Kelly** teaches the method of Claim 26 further comprising the step of storing group organization (merchant) information in an ad user database connected to a commercial message server, the merchant information comprising a sales queue (merchant identifier) and a prompt (commercial message identifier) (Col. 16, lines 20-30).

As to Claims 30,36-38, with respect to Figures 1-6, **Kelly** teaches a voice communications device comprising:

a network interface to communicate using at least one data communications channel over a data network, the data communications channel including at least one voice over data communications channel (Figure 5, label 540);

a voice over data processor to convert voice signals to voice over data signals, and to convert voice over data signals to voice signals, the voice over data signals being communicated on the voice over data communications channel (Figure 5, labels 520 and 530);

Art Unit: 2645

a signaling stack to send a request comprising a callee identifier to initiate a telephone call and to send a response to a received request to initiate a telephone call from another voice communications device (Figure 5 and Col. 16, lines 49-53); and

a message display device to display at least one commercial message received over the data network while the voice communications device is communicating the voice over data signals on the voice over data communication channel (Col. 16, lines 35-39 and line 64 through Col. 17, line 4).

As to Claims 42-43, **Kelly** teaches the commercial message server of Claim 41 wherein the ACD server (commercial message server) is operable to send the commercial message to the user identifier by sending the commercial message to the caller process (telephony connection server) (Col. 16, lines 25-30).

As to Claims 47,51-52, with respect to Figures 1-6, **Kelley** teaches a telephony connection server comprising:

a call management function operable to receive a request to initiate a telephone call using at least one voice communications device, and to send a response message in response to the request message (Figure 5 and Col. 15, line 54 through Col. 16, line 4 and 20-30);

a network telephony user database to store a user identifier for each of a plurality of users, wherein the user identifier includes a first sequence of alphanumeric elements that identify a user of a voice communications device (Col. 8, lines 19-26 and Col. 15, lines 54-64); and

Art Unit: 2645

an advertisement service to retrieve at least one commercial message from a commercial message server and to communicate the commercial messages in the response message (Col. 16, lines 20-30).

As to Claim 53, with respect to Figures 1-5, **Kelly** teaches a memory for storing commercial messages comprising:

a sales group (merchant record) for identifying a merchant corresponding to the commercial messages (Col. 16, lines 1-5 and 21-24); and

a connection to a data network to transport the commercial messages to a plurality of voice communications devices while the plurality of voice communication devices are communicating voice signals as data packets (Col. 16, lines 25-29 and line 64 through Col. 17, line 4).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

Art Unit: 2645

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 3-7, 24-25 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kelly** in view of **Giordano, III et al.** (US 6,285,364).

As to Claims 3-7 and 31-34, **Kelly** teaches the system of Claim 2 wherein the first data network telephone further comprises:

Kelly does not teach the following limitation:

“at least one speed dial key operable to initiate a second voice over data channel to a called party at a selected voice communications device when the speed dial key is assigned to the called party's user identifier”

However, it is obvious that **Kelly** suggests the limitation. This is because **Kelly** teaches sending keypad information to callers (Col. 16, lines 29-32). **Giordano, III** teaches the limitation (Figure 2 and Col. 5, lines 30-38). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add speed dial key capability to **Kelly's** invention for accessing alternate sites as taught by **Giordano, III's** invention in order to provide speed dial connections over data networks.

As to Claims 24-25, with respect to Figures 1-6, **Kelly** teaches a method for programming at least one speed dial key on a voice communications device comprising the steps of

receiving a commercial message having a speed dial key program having a selected user identifier corresponding to a selected voice communications device (Col. 16, lines 25-32); and

assigning the selected user identifier to the speed dial key such that the voice communications device initiates a voice over data connection to the selected voice communications device identified by the selected user identifier when the user presses the speed dial key (Col. 16, lines 32-46);

Kelly does not teach the following limitation:

“a speed dial key”

However, it is obvious that **Kelly** suggests the limitation. This is because **Kelly** teaches sending keypad information to callers (Col. 16, lines 29-32). **Giordano, III** teaches the limitation (Figure 2 and Col. 5, lines 30-38). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add speed dial key capability to **Kelly**'s invention for accessing alternate sites as taught by **Giordano, III**'s invention in order to provide speed dial connections over data networks.

7. Claims 8 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kelly** in view of **Giordano, III** and further in view of **Oran** (US 6,275,574).

As to Claims 8,35, **Kelly** teaches the system of Claim 3 wherein the selected voice communications device is a Public Switched Telephone Network (PSTN) phone;

Kelly does not teach the following limitation:

Art Unit: 2645

“the user identifier includes a telephone number according to the E.164 protocol”

Oran teaches the limitation (Col. 2, lines 15-34). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add E.164 capability to **Kelly's** invention for mapping telephone numbers as taught by **Oran's** invention in order to provide completion of calls over legacy voice networks.

8. Claims 11-16, 18-19, 39-40, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kelly** in view of **Oran** (US 6,275,574).

As to Claims 11-12, 39-40, **Kelly** teaches the system of Claim 9;

Kelly does not teach the following limitation:

“wherein the user identifiers include Session Initiation Protocol (SIP) addresses”

Oran teaches the limitation (Col. 6, lines 1-18). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add SIP capability to **Kelly's** invention for mapping telephone numbers as taught by **Oran's** invention in order to provide completion of calls over legacy voice networks.

As to Claims 13-16, 18-19, **Kelly** teaches the system of Claim 1 further comprising:

a network telephony user database connected to the data network to store a user identifier and a telephone identifier corresponding to the user identifier for each of a plurality of users;

Art Unit: 2645

a network telephony connection server operable to receive a request message from the first data network telephone to initiate the voice over data channel with the second data network telephone, and to send a response message in response to the request message.

wherein:

Kelly does not teach the following limitations:

- (a) the user identifier includes a first sequence of alphanumeric elements that identify a corresponding user
- (b) the telephone identifier includes a second unique sequence of alphanumeric elements that identifies a corresponding data network telephone

Oran teaches the limitation (Col.7, lines 35-60). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add identifier capability to **Kelly's** invention for mapping telephone numbers as taught by **Oran's** invention in order to provide completion of calls over legacy and data networks.

As to Claim 44, **Kelly** teaches the commercial message server of Claim 43:

Kelly does not teach the following information:

“wherein the data communications channel uses the RTP protocol to transport the commercial message”

Oran teaches the limitation (Col. 8, lines 40-46). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add RTP capability to **Kelly's** invention for mapping telephone numbers as taught by **Oran's** invention in order to provide completion of calls over legacy and data networks.

Art Unit: 2645

9. Claims 21 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kelly** in view of **Marino et al.** (US 4,850,007).

As to Claim 21, **Kelly** teaches the method of Claim 20 further comprising the steps of:

Kelly does not teach the following limitation:

“sending at least one commercial message to the second data network telephone”

However, it is obvious that **Kelly** suggests the limitation. This is because **Kelly** teaches that the information is transmitted and exchanged between a caller and an agent (Col. 16, line 64 through Col. 17, line 4). **Marino** teaches the limitation (Col. 4, lines 10-14). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add ad playing capability to **Kelly**'s invention for sending advertisements to callers and called parties as taught by **Marino**'s invention in order to allow a caller and called party to listen to advertisements.

As to Claim 46, **Kelly** teaches the commercial message server of Claim 45:

Kelly does not teach the following limitation:

“wherein the commercial message database includes merchant account information to maintain commercial messages and billing information for merchants”

Marino teaches the limitation (Figure 2). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add billing capability to **Kelly**'s invention for sending advertisements to callers as taught by **Marino**'s invention in order to provide rewarding service to advertisers.

Response to Arguments

10. Applicant's arguments filed 8/29/02 have been fully considered but they are not persuasive because of the following:

35 USC 102 Rejections

(a) Claims 1-2, 9-10

Kelly does not teach communicating commercial messages at Col. 16, lines 25-30.

Examiner respectfully disagrees. This is because **Kelly** teaches that a caller waiting in a sales queue hears please wait commercial messages and can request music or advertisements which are commercial messages. In addition, if the caller presses 1, a thank you commercial message is played to the caller (Col. 16, lines 41-48).

(b) Claims 20,22-23,26-29

Kelly does not disclose a commercial message request.

Examiner respectfully disagrees for the same reasons given in (a). In addition, the disclosure teaches that commercial messages advertise for a merchant (Page 15, lines 14-15). **Kelly** teaches sales and support messages for a company (merchant) (Col. 15, lines 1-10).

(c) Claims 30 and 36-38

Kelly does not teach sending a request with the callee identifier.

Examiner respectfully disagrees. This is because **Kelly** teaches a call to a sales or support group (callee identifier) (Col. 16, lines 1-4).

(d) Claims 41-43 and 45

Art Unit: 2645

Kelly does not teach a commercial server because **Kelly** does not disclose a telephony connection server interface to receive connection information.

Examiner respectfully disagrees. This is because **Kelly** teaches that ACD server communicates with a connection server for setting up a call to a sales or support group (callee identifier) (Col. 15, line 54 through Col. 16, line 4). In addition, Kelly teaches that ACD server communicates with connection server for verifying a caller's connection (Col. 16, lines 8-16). Therefore, ACD server has an interface to connection server for receiving connection information from the connection server.

(e) Claims 47, 51-52

Kelly does not teach a connection server that comprises an advertisement service.

Examiner respectfully disagrees. This is because **Kelly** teaches that a caller contacts connection server for Sales that references ACD server (Col. 15, line 62 through Col. 16, line 4). This passage teaches that the connection server comprises the ACD server which is an advertisement service for Sales.

(f) Claim 53

Kelly does not teach a merchant record for identifying a merchant corresponding to the commercial messages.

Examiner respectfully disagrees. This is because **Kelly** teaches that a caller contacts connection server for Sales that references ACD server (Col. 15, line 62 through Col. 16, line 4). This passage teaches that Sales@Company.com is a record of a merchant for which commercial messages are played to a caller.

Art Unit: 2645

35 USC 103 Rejections

(a) Claims 3-7, 24-25 and 31-34

Claims 3-7 and 31-34 are allowable because of their dependency on claims 1 and 30 respectfully.

Examiner respectfully disagrees because of the same reasons given with respect to claims 1 and 30.

Claims 24-25 are allowable because Col. 16, lines 25-32 does not teach a commercial message having a speed dial key program.

Examiner respectfully disagrees. This is because the “please wait ...” is a commercial message and it suggests speed dial keys because the caller “presses” the keys to achieve a particular function (Col. 16, lines 39-42). It would have been obvious to combine **Kelly** with **Giordano** to achieve speed dial keys.

(b) Claims 8 and 35

These claims are allowable because of their dependencies on Claims 1 and 30 respectfully.

Examiner respectfully disagrees because of the same reasons given with respect to claims 1 and 30.

(c) Claims 11-16 and 18-19

These claims are allowable because of their dependency on claim 1.

Examiner respectfully disagrees because of the same reasons given with respect to claim 1.

(d) Claims 39-40

These claims are allowable because of their dependency on claim 30.

Examiner respectfully disagrees because of the same reasons given with respect to claim 30.

(e) Claim 44

This claim is allowable because of its dependency on claim 41.

Examiner respectfully disagrees for the same reasons given with respect to claim 26.

(f) Claims 21 and 46

These claims are allowable because of their dependencies on claims 20 and 41 respectfully.

Examiner respectfully disagrees for the same reasons given with respect to claims 20 and 26 respectfully.

Invitation

Examiner respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bilder (US 6,400,804) teaches providing advertisements to on-hold parties.

Gregorek et al. (US 5,557,658) teach parties to a call selecting advertisement messages.

Art Unit: 2645

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 306-0377 (for customer service assistance)

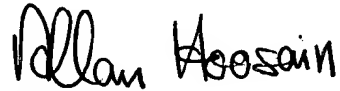
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

Art Unit: 2645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read "Allan Hoosain". The signature is stylized with a large initial "A" and "H".

Allan Hoosain

Primary Examiner

10/28/02